

REMARKS/ARGUMENTS

Claims 1, 2, 5-14, 19-22, 28, 29, and 44-58 are pending in the application. The Applicant hereby requests further examination and reconsideration of the application in view of these remarks.

Art Rejections

In paragraph 2 of the office action, the Examiner rejected claims 1, 2, 5-7, 9, 10, 12, 13, 19-22, 28, 29, 44, 45, 47-50, 52-55, 57, and 58 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,628,768 ("Ramaswamy") in view of U.S. Patent No. 4,640,987 ("Tsukada"). In paragraph 3, the Examiner indicated that claims 8, 11, 14, 46, 51, and 56 would be allowable if rewritten in independent form.

For the following reasons, the Applicant submits that all of the pending claims are allowable over the cited references.

Claims 1, 2, 5, 19-22, 28, and 29

Claim 1 recites:

1. A method of answering an incoming call at a cordless telephone having a base unit and a plurality of cordless handsets, each of said base unit and plurality of cordless handsets being at a different location, the method comprising the steps of:

answering, by a first party, the incoming call at one of said plurality of cordless handsets;

after the incoming call is answered and while the incoming call is active, initiating an intercom connection between cordless handsets, by an intercom initiating party, to alert an intercom receiving party, the intercom connection permitting voice communication between the intercom initiating party and the intercom receiving party;

automatically placing said incoming call in a hold status if either said intercom initiating party or said intercom receiving party is also said first party; and

accepting said incoming call at another one of said plurality of cordless handsets, by said intercom receiving party, by terminating the hold status.

Claim 1 recites the steps of "answering, by a first party, the incoming call at one of said plurality of cordless handsets" and "accepting said incoming call at another one of said plurality of cordless handsets, by said intercom receiving party." Accordingly, claim 1 requires, *inter alia*, that a call be (i) answered at a first cordless handset by a first party and then (ii) accepted at a second cordless handset by a second party.

In rejecting claim 1, the Examiner alleged on pages 2-3 of the office action that Ramaswamy teaches (i) "answering an incoming call at a cordless telephone having a base unit and a plurality of cordless handsets," (ii) "initiating an intercom connection between cordless handsets," and (iii) "accepting [an] incoming call [at] another one of [the] plurality of cordless handsets." These allegations are incorrect. Nowhere does Ramaswamy teach, disclose, or even suggest these steps.

Rather, Ramaswamy teaches transferring a call only from a **base unit to a cordless handset, not from one cordless handset to another cordless handset**. For example, FIG. 4 of Ramaswamy

illustrates the operation of the base unit (col. 5, line 67). Block 102 of FIG. 4 shows that “the microprocessor 40 **in the base unit** 30 begins to monitor the external telephone line 5 on which the conference call is taking place” (col. 6, lines 5-7) (emphasis added). After the base unit detects an incoming call, “[i]n block 112, an indication that an incoming call is waiting, which may be in the form of a beep, is sent from the **base unit** 30 to **all of the handsets** 20 involved in the conference call, along with caller ID information related to the incoming call. The base unit 30 then begins to wait for a response from the handsets 20. In block 114 a **test is made to determine if a handset has responded. If so, then a portion 200 of the microprocessor 40 program [in the base unit] is executed to respond to the incoming call**” (col. 6, lines 13-21) (emphasis added). Eventually, either “the **external conference call party is temporarily disconnected from the base unit** 30 (i.e. is put on hold), and **the controlling handset 20 is coupled to receive the incoming call**,” (col. 6, lines 49-52), or else **the base unit** sends a pre-recorded message to the outside caller instructing them to hang up, disconnects the outside caller, and then calls the outside caller back to connect that caller **to a handset** (col. 6, line 57 – col. 7, line 22).

As clearly seen from the portions of Ramaswamy discussed above, Ramaswamy fails to teach, in any way, **transferring calls between cordless handsets**, nor how calls could possibly be transferred between cordless handsets. All that these portions of Ramaswamy teach is a base unit transferring a call to a handset while that handset is involved in a multi-party conference call.

Nor are the missing teachings supplied by Tsukada. As admitted by the Examiner on page 3 of the office action dated 10/4/10, Tsukada teaches a cordless phone having a base unit 2A and **only a single cordless handset** 1A and therefore fails to disclose a cordless telephone having a plurality of cordless handsets. Although Tsukada teaches transferring calls from a base unit to a cordless handset (e.g., col. 13, line 55, through col. 15, line 22), just as with Ramaswamy, Tsukada’s teachings are limited to a base unit and a cordless handset. Tsukada provides no teachings whatsoever regarding how to transfer calls between cordless handsets.

Indeed, neither Ramaswamy nor Tsukada teaches a method for **transferring calls between cordless handsets**. Tsukada does not even involve multiple cordless handsets, and Ramaswamy teaches transferring a call from a base unit to a handset while that handset is involved in a multi-party conference call – but fails to teach, disclose, or even suggest transferring calls between cordless handsets. Nor is there even a suggestion in either reference of how a call could possibly be transferred from one cordless handset to another cordless handset. The Applicant’s teachings of transferring a call **from one cordless handset to the other** simply cannot be derived from any combination of these references.

Accordingly, no combination of Ramaswamy and Tsukada could possibly render claim 1 obvious.

Moreover, the motivation alleged by the Examiner for combining Ramaswamy and Tsukada is that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Tsukada to Ramaswamy to a cordless telephone having a transfer capability between units and easy to carry.” This motivation makes no sense, for several reasons.

First, the Examiner is apparently arguing that the reason for combining Ramaswamy and Tsukada is to provide “a cordless telephone having a transfer capability between units [handsets].” However, the teaching of a cordless telephone that permits transfer between handsets is a teaching of the Applicant, not of the prior art. The Examiner has cited no references that either implicitly or explicitly suggest that it would be desirable to have a cordless telephone that permits transferring calls between handsets. The argument that one skilled in the art would have been motivated to combine Ramaswamy and Tsukada to arrive at a cordless telephone that permits transferring calls between handsets – for the reason that it

would be desirable to have a cordless telephone that permits transferring calls between handsets –merely restates a conclusion, without any evidentiary support for the reason to combine these references.

Second, the Examiner is apparently arguing that another reason for combining Ramaswamy and Tsukada is to provide a cordless telephone that is “easy to carry.” It is respectfully submitted that this reason is also improper. Ramaswamy already teaches a telephone having a cordless handset (col. 1, lines 18-21), so it does not make sense that Ramaswamy would turn to Tsukada for the teaching of a cordless handset.

For at least the foregoing two reasons, the motivation alleged by the Examiner is improper. There is no other motivation provided by the Examiner or found in the cited references, other than this improper motivation.

Since there is no proper motivation or suggestion in the art to combine Ramaswamy and Tsukada, these references cannot properly be combined to render claim 1, or any other claim of the present application, obvious. In view of the foregoing, the Applicant submits that it is improper to combine Ramaswamy and Tsukada to reject claim 1 as obvious. As such, the Applicant respectfully submits that claim 1 is allowable over Ramaswamy and Tsukada.

Even under the obviousness analysis provided by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401, 127 S. Ct. 1727 (2007), it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. Moreover, in her May 3, 2007 Memorandum to Technology Center Directors, Margaret A. Focarino, Deputy Commissioner for Patent Operations, clearly states that “in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” This necessity was confirmed in the 2010 *KSR Guidelines Update* published by the USPTO on September 1, 2010 (Federal Register, Vol. 75, No. 169 at 53645), which reiterated that:

the 2007 *KSR* Guidelines and MPEP § 2143 state: “The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” MPEP § 2143. In *Ball Aerosol v. Limited Brands*, 555 F.3d 984 (Fed. Cir. 2009), the Federal Circuit offered additional instruction as to the need for an explicit analysis. The Federal Circuit explained, as is consistent with the 2007 *KSR* Guidelines, that the Supreme Court’s requirement for an explicit analysis does not require record evidence of an explicit teaching of a motivation to combine in the prior art. [T]he analysis that “should be made explicit” refers not to the teachings in the prior art of a motivation to combine, but to the court’s analysis * * *. Under the flexible inquiry set forth by the Supreme Court, the district court therefore erred by failing to take account of “the inferences and creative steps,” or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art. *Ball Aerosol*, 555 F.3d at 993. The Federal Circuit’s directive in *Ball Aerosol* was addressed to a lower court, but it applies to Office personnel as well. When setting forth a rejection, Office personnel are to continue to make appropriate findings of fact as explained in MPEP §§ 2141 and 2143, and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. This requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity.

In the present application, the Examiner has failed to identify any valid reason for combining Ramaswamy and Tsukada, and therefore, the §103 rejection is improper.

For all these reasons, the Applicant submits that claim 1 is allowable over the cited references. For similar reasons, the Applicant submits that claim 5 is also allowable over the cited references. Since claims 2, 19-22, 28, and 29 depend variously from claims 1 and 5, it is further submitted that those claims are also allowable over the cited references.

Claims 6-14 and 44-58

Claim 6 recites:

6. A cordless telephone system comprising:
a base station including first control circuitry for controlling operations at said base station; and
at least two cordless telephone handsets for communicating with said base station, each including second control circuitry for controlling operations at said cordless telephone handset;
said first and second control circuitry operating in response to initiation of an intercom communication at a first of said cordless telephone handsets to **place an active call at the first cordless telephone handset on hold during said intercom communication**, the intercom communication permitting voice communication between at least two of said cordless telephone handsets.

The Examiner alleged that Ramaswamy teaches all of the foregoing recited features, except for a cordless handset, concluding that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Tsukada to Ramaswamy to a cordless telephone having a transfer capability between units and easy to carry."

However, even the combined teachings of the Ramaswamy and Tsukada references are severely deficient and fail to render the Applicant's claim 6 obvious, as will now be discussed.

Claim 6 recites that the first and second control circuitry "place an active call at the first cordless telephone handset on hold during said intercom communication" in response to the initiation of an intercom communication "permitting voice communication between at least two of said cordless telephone handsets."

As fully discussed above regarding the rejection of claim 1, the combination of Ramaswamy and Tsukada fails to teach a method for transferring calls between cordless handsets. Similarly, neither reference teaches placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset.

Tsukada does not even involve multiple cordless handsets, and Ramaswamy teaches using cordless handsets only for making and receiving calls, including conference calls, via an outside line or intercom calls between cordless handsets – but fails to teach, disclose, or even suggest placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset.

Although Ramaswamy teaches placing a conference call on hold to answer another call using the "call waiting" feature (see, e.g., col. 6, lines 45-56), Ramaswamy's teachings are limited to placing a call with an outside caller on hold using "call waiting," not placing an outside call on hold during an intercom communication between handsets. Ramaswamy provides no teachings whatsoever regarding how to

place a call on hold at a cordless handset so that cordless handsets can connect to each other for an intercom communication. Thus, neither Ramaswamy nor Tsukada, whether alone or in combination, teaches, discloses, or even suggests that missing teachings of **placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset**, as required by the recitations of claim 6.

Accordingly, no combination of Ramaswamy and Tsukada could possibly render claim 6 obvious.

Moreover, as argued above with respect to the rejection of claim 1 over Ramaswamy and Tsukada, the motivation alleged by the Examiner is improper, and there is no other motivation provided by the Examiner or found in the cited references, other than the improper motivation.

Since there is no proper motivation or suggestion in the art to combine Ramaswamy and Tsukada, these references cannot properly be combined to render claim 6, or any other claim of the present application, obvious. In view of the foregoing, the Applicant submits that it is improper to combine Ramaswamy and Tsukada to reject claim 6 as obvious. As such, the Applicant respectfully submits that claim 6 is allowable over Ramaswamy and Tsukada.

For all these reasons, the Applicant submits that claim 6 is allowable over the cited references. For similar reasons, claims 9, 12, 44, 49, and 54 are also allowable over the cited references. Since claims 7, 8, 10, 11, 13, 14, 45-48, 50-53, and 55-58 depend variously from claims 6, 9, 12, 44, 49, and 54, it is further submitted that those claims are also allowable over the cited references.

Conclusion

The Applicant submits therefore that the rejections of claims under Section 103 have been overcome.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to Mendelsohn, Drucker, & Associates, P.C. Deposit Account No. 50-0782.

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

Date: 06/10/2011
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